

REMARKS

Claims 1, 3, 4, 7-10, 13, 18, 20, 24-27, 35, and 37-48 were pending and under consideration. Applicants have amended claims 1, 20, and 45, added claims 49-51, and cancelled claim 48. Accordingly, claims 1, 3, 4, 7-10, 13, 18, 20, 24-27, 35, 37-47, and 49-51 are now pending and under consideration.

Claims 1, 3, 4, 7-10, 13, 18, 20, 24-27, 35, and 37-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rydell (5,810,809) (Rydell '809). Applicants respectfully submit that claims 1, 3, 4, 7-10, 13, 18, 20, 24-27, 35, and 37-48 are patentable over Rydell '809.

Claims 1 and 20 relate to a surgical apparatus including a surgical tool. The surgical tool includes a shaft and a tip. The shaft is mechanically and electrically coupled at a distal end to the tip. The shaft is also coupled to a drive interface and an electrical interface with the drive interface producing or permitting a surgical motion of the tip and the electrical interface producing or permitting a cauterizing action at the tip.

Regarding claims 1, 20, 37, and 38, Rydell '809 does not describe or suggest at least the claimed shaft coupled to a drive interface and an electrical interface with the drive interface producing (claims 1 and 37) or permitting (claims 20 and 38) a surgical motion of a tip and the electrical interface producing (claims 1 and 37) or permitting (claims 20 and 38) a cauterizing action at the tip. Rather, in Rydell '809, there is one tube 20 that is used to produce or permit a cauterizing action at a tip, and a second tube 24 that is used to produce or permit a surgical motion of a tip. There is no one shaft in Rydell '809 that provides both the electrical and mechanical coupling of the claims.

Therefore, applicants submit that claims 1, 20, 37, and 38, and their dependent claims, are patentable over Rydell '809.

Regarding claim 45, Rydell '809 does not describe or suggest at least the claimed "producing a surgical motion of the conducting portion . . . and applying . . . the conducting portion to the surgically operated tissue to produce a cauterizing action" (claim 45). Rather, Rydell '809 describes a rotating inner tube 24, mounted within a stationary outer tube 20 (col. 3, lines 39-43 and col. 5, lines 1-21), with cauterization occurring only at a distal portion 12 of the

stationary outer tube 20 (col. 5, lines 42-44 and 55-59). Thus, cauterizing action is produced in Rydell '809 only at stationary surface 12 that does not have a surgical motion.

Therefore, applicants submit that claim 45 and its dependent claims are patentable over Rydell '809.

Dependent claims 7-10 and 24-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rydell '809 in view of Auth et al. (4,532,924). Applicants submit that Auth et al. do not overcome the deficiencies of Rydell '809. Auth et al. do not describe or suggest at least a shaft that is coupled to a drive interface to produce or permit a surgical motion of a tip (claims 1 and 20) or "producing a surgical motion of the conducting portion" (claim 45). Rather, Auth et al. describe a bullet-shaped electrosurgical device 22 (col. 5, lines 11-12) that has no surgical motion and is used solely for cauterization (Figs. 1-2; col. 6, lines 41-48).